

REMARKS

At the time of the Office Action dated February 27, 2007, claims 1-35 were pending and rejected in this application.

Claims 1, 6-7, 13-15, and 23-22 have been amended, and claims 25-32 have been cancelled. Care has been exercised to avoid the introduction of new matter, and Applicants submit that the present Amendment does not generate any new matter issue.

CLAIMS 25-32 ARE REJECTED UNDER 35 U.S.C. § 101

On page 2 of the Office Action, the Examiner asserted that the claimed invention, as recited in claims 25-32, is directed to non-statutory subject matter. Claims 25-32 have been cancelled, and therefore, this rejection is moot.

**CLAIMS 1-35 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
BRAHM ET AL., U.S. PATENT NO. 7,103,167 (HEREINAFTER BRAHM), IN VIEW OF HO ET AL., U.S.
PATENT NO. 6,947,730 (HEREINAFTER HO)**

On pages 2-5 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have arrived at the claimed invention based upon the combination of Brahm and Ho. This rejection is respectfully traversed.

Claims 1, 9, and 17

On page 3 of the Office Action, the Examiner asserted the following regarding the teachings of Brahm:

In regards to claims 1, 9, 17, and 25, Brahm discloses a telephone, method, and computer storage medium having a first connection to a packet switched network (See Fig. 1 and Internet 106) comprising apparatus for receiving from the packet switched network presence indicators associated with some of the telephone numbers, a memory for storing the presence indicators in association with their corresponding telephone numbers, and apparatus responsive to a selection of an entity by a user for selecting a number for dialing based on the state of the presence indicators associated with the selected entity (See col. 2 lines 56-66 and col. 5 lines 30-41).

At the outset, Applicants note that the device claim (i.e., claim 1) is to a telephone and that claims 9 and 17 recite a method being performed on a telephone. However, the teachings identified by the Examiner within Brahm do not refer to a telephone. Column 2, lines 56-66 generally refers to an Internet Answering Machine (IAM) system, and column 5, lines 30-41 also refers to the components of IAM system 124. Referring to Fig. 1 of Brahm, the IAM system 124 is completely separate from the telephones 102, 112. Thus, the Examiner's description of the teachings of Brahm is not completely factually correct.

Moreover, claims 1, 9, and 17 each recite that upon "responsive to a selection of an entity by a user," the following occurs "selecting a number for dialing based on the state of the presence indicators associated with the selected entity." Reference is made to column 2, lines 56-63 of Brahm's, which was cited by the Examiner and is reproduced below:

In another embodiment, rather than opening a channel over the Internet to the called party's computer, a second call is selectively originated upon the arrival of the forwarded call to a second POTS Public Switched Telephone Network (PSTN) phone line or the called party's wireless/cellular phone. The IAM system determines which of the POTS lines and cellular lines to call and which calls are to be forwarded based on a set of rules defined by the called party.

Unlike the claimed step, which is responsive to "a selection of an entity by a user," the teachings identified by the Examiner are responsive to another party calling the first party. Thus, Brahm further fails to teach the limitations for which Brahm is being relied upon to teach.

The Examiner further asserted the following on page 3 of the Office Action regarding the teachings of Brahm and Ho:

Although Brahm inherently discloses an apparatus for storing multiple identifications of one or more entities selectable by a user of the telephone that can be called from the telephone, and an apparatus for storing one or more telephone numbers associated with each entity, Ho, more specifically discloses this feature (See Abstract and col. 2 lines 54-67).

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to incorporate these features within the system, as a way of increasing answering probability without requiring user searching, thereby effectively reducing the time spent on user searches for other multiple telephone numbers as well as the annoying dialing of multiple telephone numbers.

The Examiner's proposed modification does not lead to the Examiner asserted benefit for the proposed modification.

The Examiner's analysis fails to explain how "storing multiple identifications of one or more entities selectable by a user of the telephone" leads to "increasing answering probability without requiring user searching." In this regard, Applicants respectfully submit that the Examiner has failed to establish a nexus between the teachings relied upon within Ho for the proposed modifications to Brahm and the asserted benefit for "increasing answering probability without requiring user searching."

A nexus is required between the proposed modification and the asserted benefit of the modification. The need for a nexus between the proposed modification and the asserted benefit of the modification is to establish that one having ordinary skill in the art would have been realistically impelled to modify the prior art in the manner suggested by the Examiner.

Otherwise, the Examiner could assert that any possible modification taught by Ho could be based upon any possible benefit taught by Ho. Thus, for the reasons stated above, Applicants

respectfully submit that the Examiner has failed to set forth a prima facie case of obviousness for lack of a proper, realistic rationale to modify Brahm in view of Ho.

Claim 33

With regard to claim 33, the Examiner asserted the following on page 4 of the Office

Action:

In regards to claims 4, 12, 20, 28, 33, and 34, Brahm discloses the telephone, method, and computer storage medium, the apparatus for storing the identifications of entities, the telephone numbers associated with the entities and the presence indicators (See col. col. 2 lines 56-66 and col. 5 lines 30-41), a memory for storing the name of the entities, means allowing a user to select an entity for dialing, and means for transmitting a name of a selected entity to the base station (for example, the name is transmitted to the base station if a wireless/cellular device is used) (See col. 18 lines 18-32).

Independent claim 33 recites "apparatus in the base station for storing one or more network addresses associated with an identification for calling an entity, and for interrogating an entity presence indicator associated with a network address to determine if the user is located at that network address." However, upon reviewing the Examiner's analysis, as reproduced above, it is readily evident that the Examiner has failed to establish where this particular feature is taught either Brahm or Ho, either alone or in combination. Thus, the Examiner has failed to establish a prima facie case of obviousness in rejection claim 33.

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 1-24 and 33-35 under 35 U.S.C. § 103 for obviousness based upon Burnett in view of Yamamoto is not viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the

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Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: May 29, 2007

Respectfully submitted,

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